

REMARKS

Applicant has carefully reviewed the Application in light of the final Office Action mailed October 19, 2006. At the time of the final Office Action, Claims 1-33 were pending and rejected in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejections

The Examiner continues to reject Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, 25-28, 30-31, and 33 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 6,119,014 issued to Alperovich et al. (hereinafter "*Alperovich*") in view of U.S. Patent No. 5,705,995 issued to Laflin et al. (hereinafter "*Laflin*") and further in view of WO 99/35778 issued to Kadyk (hereinafter "*Kadyk*"). The Examiner also rejects Claims 5, 13, 21, 29, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of *Laflin* and *Kadyk* as applied to Claims 4, 12, 20, and 25, and further in view of what is well known in the art. The Examiner also rejects Claims 8, 16, 24, and 32 under 35 U.S.C. §103(a) as being unpatentable over *Alperovich* in view of *Laflin* and *Kadyk* as applied to Claims 1, 9, 17, and 25 above, and further in view of U.S. Publication No. 2001/0041571 A1 issued to Yuan (hereinafter "*Yuan*"). These rejections are respectfully traversed for the following reasons.

As a preliminary matter, Applicant is ready to Appeal this case. The Examiner is well aware that [statistically] three-reference §103-rejections rarely survive the Appeal process. Applicant will file this Notice of Appeal on January 19, 2007 as is required. Presumably, the Examiner will not read the subsequent arguments concerning this most recent Office Action. There are only two courses of action for the Examiner at this juncture: 1) run through the Appeal process; or 2) go back in the stacks and find better art. In the rare case that the Examiner will actually read the latest proffered arguments, they are earnestly offered below.

The primary reference being used in this case is flawed in that *Alperovich's* architecture cannot analyze the message to determine if it contains pushed data, determine if the message contains pushed data, whether the pushed data is appropriate for a session currently being hosted by the mobile unit, and post the pushed data to the session if the data

is appropriate for the session. The Examiner concedes this point, but offers *Laflin* to fill this void. In a separate endeavor, *Laflin* is similarly flawed, but the Examiner concedes that while he proffers *Kadyk* for additional deficiencies of the Prior Art.

Lacking in these references is the requisite motivation or suggestion to combine these elements to achieve the filtering operation of the present invention. This lack of suggestion or motivation is a clear violation of the first prong of non-obviousness, of which the Examiner is intimately familiar. Applicant wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, the proposed *Alperovich-Laflin-Kadyk* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Laflin*, *Alperovich*, *Kadyk* or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.¹ Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.² Nothing in *Alperovich* or in *Laflin* or in *Kadyk* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.³ Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.⁴ and governing Federal Circuit case law.⁵ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁶

¹ M.P.E.P. § 2143.01 (emphasis in original).

² *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

³ If “common knowledge” or “well known” art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

⁴ See M.P.E.P. § 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

⁵ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion,

Obviousness can never be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.⁷ The factual inquiry whether to combine references must be thorough and searching.⁸ This factual question cannot be resolved on subjective belief and unknown authority;⁹ it must be based on objective evidence of record.¹⁰

The Examiner is precluded from modifying the combined teachings of *Alperovich* and *Laflin* and *Kadyk* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹¹ The fact that the modification is possible or even advantageous is not enough.¹² A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹³

The Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The combinations of *Alperovich* and *Laflin* and *Kadyk* would not be capable of performing the operations required by the claimed invention. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability to achieve the

teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

⁶ See M.P.E.P. §2145.

⁷ See *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986).

⁸ See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

⁹ See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002).

¹⁰ *Id.* at 1343, 61 USPQ 2d at 1434.

¹¹ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹² See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹³ *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

filtering function. With the filtering operation, the mobile device can make an evaluation of whether or not the selected data is appropriate for the session. Absent a filtering operation, there is no control provided to the mobile device for which type of data propagates to the end users. Undesired data consumes resources, augments processing loads, and hampers the end user's experience. There is nothing in any reference that provides a coherent filtering function for the mobile device.

The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Alperovich-Laflin-Kadyk* combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

Assuming, for the sake of argument, that *Laflin* and *Alperovich* are analogous art, and that there is the required suggestion or motivation to combine *Alperovich* with *Laflin* and *Kadyk*, the proposed *Alperovich-Laflin-Kadyk* combination would fail because the limitations specifically recited in the pending claims are not disclosed in each of the references, as evaluated extensively above. Accordingly, such an argument is flawed in that it does not satisfy the third criterion of obviousness, as identified in the analysis above.

For at least these reasons, Independent Claim 1 is clearly allowable over the proposed combinations. In addition, Independent Claims 9, 17, 25, and 33 include a limitation that is similar, but not identical, to that of Independent Claim 1. Accordingly, these Independent Claims are also allowable over the proffered combinations using a similar rationale. Additionally, the dependent claims corresponding of these Independent Claims are also allowable for analogous reasons.

Thus, all of the pending claims have been shown to be allowable, as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

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CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,
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